

### **REMARKS**

Applicants respectfully request reconsideration of this application in view of the foregoing amendments and following remarks.

#### **Claims Status**

Claims 1-14 are pending in this application. Claims 1-3 and 8-10 are rejected and claims 4-7 and 11-14 have been objected to. Claims 1 and 8 are independent in form. Claims 1 and 8 are herein amended and new claims 17-20 are added. No new matter has been added.

#### **Prior Art Rejections Under 35 USC §102(a)**

In the outstanding Office Action, claims 1 and 8 have been rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Needham. Claims 2-3 and 9-10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Needham in view of Tanaka and Hoskinson.

#### **Claims 1 and 8**

In the rejection of claim 1, the Examiner has taken the position that "Needham discloses a method for processing an emergency call made from behind a PBX/MLTS coupled to an analog or ISDN private network, the method comprising the steps of: within the PBX/MLTS determining whether dialed digits represent an emergency number, and assigning priority within PBX/MLTS to a call determined to be an emergency call, such that call takes priority over other calls in traversing the private network (reads on PBX and associated ISDN trunks) before reaching the public network trunk (24, fig. 1, page 3 lines 17-33 page 4 lines 1-6, lines 27-32)." Similarly for claim 8. (See pages 2-3, ¶2 of the Office Action.) Further, on page 5 of the Office Action, the Examiner comments that "...Needham teaches a PBX/MLTS coupled to ISDN network as shown in fig. 1" which is alleged to form the claimed private network.

Applicants respectfully do not agree with the Examiner with regard to the teachings attributed to Needham and respectfully submit that Needham does not teach or suggest the invention as recited in claim 1 or 8. Applicants traverse these rejections.

Specifically, Applicants respectfully submit that Needham does not teach or disclose a PBX/MLTS that is coupled to one or more private networks nor does it disclose assigning a priority to the emergency call in traversing the private network, as the Examiner contends, and that the teachings of Needham cannot fairly be extended thereto.

Needham describes its system configuration at page 2, line 31 to page 3, line 8 (emphasis added):

Figure 1 shows the basic configuration of the system according to the present invention. A plurality of users 10 are organized into individual call groups 12A, 12B, 12C, etc., identified by respective DID (Direct Inward Dialing) numbers or DN (Directory Number) numbers. The telephone extensions from the individual groups 12A, 12B, 12C, etc., are connected to line cards 14A, 14B, 14C, etc., of a PBX 16. The PBX 16 includes switching and call processing devices of

a well-known nature, represented in Figure 1 by call routing block 18. As discussed in greater detail below, after a DID number or DN has been assigned to a call, protocol harmonization takes place and the DID number or DN information is asserted via protocol harmonization block 22 for routing over the PSTN 24 via one of ISDN trunk cards 26A, 26B, 26C, etc.

A portion of Needham cited by the Examiner (page 3 lines 17-33 page 4 lines 1-6) explains the operation of Needham as follows (emphasis added):

In operation, when an individual (for example one of the users in call group 12C) initiates an emergency call by dialing 911 or 9-911, the call routing software 18 recognizes that the call is an emergency call which requires urgent handling. The PBX maps one or more system specific extension numbers to an ITU-T E.164 number obtained from the local telephone operating company. Each ITU-T E.164 number represents a location within a building or group of buildings served by the PBX 16. Thus, a single ITU-T E.164 number can represent multiple extension numbers that are in the same physical area. After the appropriate ITU-T E.164 number is derived, the ITU-T E.164 number is placed in the Calling Number Information Element of the Setup Message according to ITU-T recommendation Q.931, a copy of the relevant portion of which forms Appendix A to this specification. The Calling Party Number Presentation Indicator is set to "Presentation Allowed", the Bearer Capability Information Element Information transfer capability is set to "Speech" and the call is routed to one of either a ISDN PRI or BRI interface (i.e. an appropriate one of the trunks 26A, 26b, 26C, etc.).

If a PRI interface is used and all trunks are part of a call-by-call group, a channel reservation system 32 is provided to ensure that trunks are allocated for emergency calls. The algorithm keeps track of the total number of trunks/channels available on the system and the number in use at any time. Once usage exceeds a preset threshold level, which is adjustable depending on the number of lines served by the PBX 16, a busy signal is generated for any incoming or outgoing call requests other than those requesting 911 service. A flowchart of the detailed steps according to the channel reservation system is provided as Figure 2.

Needham continues in the paragraphs following the cited portion, at page 4, lines 7-10 and 27-32 (emphasis added):

According to the flowchart of Figure 2, upon user initiation of a call (Step 200), the PBX 16 checks to determine what number has been dialed (Step 205). Specifically, a determination is made as to whether the dialed number represents an emergency 911 call (Step 210).

\* \* \*

If the call is determined to be an emergency 911 call (Step 255), the extension number is translated to a 7 or 10-digit ITU-T E.164 number for that location (Step 265), and the call is routed to an ISDN trunk group (Step 270). The DID number is inserted in the calling party information element field of the setup message (Step 275), and the channel size is determined in the ISDN call-by-call

trunk group (Step 280). Finally, the call is delivered to the public network (Step 285).

The Examiner asserts that the claimed private network "reads on PBX and associated ISDN trunks" of Needham. (¶2 of the Office Action.) The Examiner appears to equate a single PBX and its associated ISDN trunks which are coupled to a public network from Needham to the PBX coupled to the private network described and claimed in the present invention. This, Applicants respectfully submit, is an unsupported interpretation of Needham.

From the foregoing excerpts it is clear that Needham specifically teaches that his PBX is not coupled to a private network, it is coupled to a public network (trunk lines) when handling an emergency call. Further Needham teaches a system implemented on one PBX 16, which interfaces to the public network PSTN 24 via ISDN trunk cards/lines 26A, 26B, 26C, etc., where the PBX 16 recognizes an emergency call, processes it and routes it, via ISDN trunk group to the public network PSTN 24. Needham thus discloses a PBX coupled to a public network via ISDN trunk lines, not a PBX coupled to a private network as claimed and nowhere mentions assigning a priority to an emergency call - Needham simply recognizes the emergency call, translates the number and forwards it to the PSTN as described in the excerpt above. While an emergency call in Needham may be given priority for a trunk line assignment for coupling onto the PSTN public network, it does not disclose a PBX coupled to a private network as claimed and consequently does not address giving priority to the emergency call for traversing that private network.

The focus of the invention claimed in claim 1 is to prioritize "an emergency call made from behind a PBX/MLTS coupled to a private network" such that "said call takes priority over other calls in traversing said private network before reaching a public network trunk."

It is respectfully submitted that the mischaracterization of the claimed invention and of Needham, which underlie the Examiner's rejection is with regard to the distinction between the PBX system and the claimed private network.

The present invention concerns the internal routing of emergency calls over a CPE private network, something not contemplated by Needham. The present invention relates to the priority routing of emergency calls made behind a PBX/MLTS and traversing a private network before reaching a public network trunk line. As defined in the specification, this can be seen in Figure 1 of the instant application where 10 is the claimed PBX/MLTS and the connections between 10 and 16, e.g., another PBX/MLTS, all part of CPE 12, form the claimed private network. According to claim 1, the emergency call "takes priority over other calls in traversing said private network before reaching a public network trunk." It is here that the present invention assigns priority to emergency calls- within the (CPE) private network. (See, e.g., fig. 5, step 80 and the corresponding description.)

Needham on the other hand, discloses recognition and processing of an emergency call within one PBX, then forwarded directly onto the public network via ISDN trunk lines. The ISDN trunk lines the Examiner contends define a "private network" are in fact between the PBX 16 (i.e., the CPE) and the public network PSTN 24, and, are not part of the (CPE) private network as defined in the present invention and therefore do not define the claimed private network. Needham, *a fortiori*, also does not teach or suggest the prioritizing of calls within that private network.

Claims 1 and 8 are therefore believed not anticipated by nor rendered obvious in view of Needham.

**Claims 2-3 and 9-10**

In the rejection of claims 2-3 and 9-10, the Examiner admits that Needham, while allegedly anticipating claims 1 and 8 from which claims 2-3 and 9-10 respectively depend, does not teach the elements of claims 2, 3, 9 and 10, specifically:

“[(c)] storing a port [equipment] number for each device/trunk in the PBX/MLTS, and [(e)] determining from which port the emergency call originated and [(d)] associating an emergency location identification number (ELIN) with each port equipment number, and [(f)] transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated.” (see ¶4, page 3 of the Office Action.)(reference letters added.)

The Examiner continues that these missing teachings are found in Tanaka and Hoskinson. The Examiner asserts that Tanaka teaches “[(c)] storing a port [equipment] number for each device/trunk in the PBX/MLTS, and [(e)] determining from which port the emergency call originated” referencing col. 9, lines 63-67, col. 10, lines 1-30 thereof, and Hoskinson discloses an emergency response system which teaches “[(d)] associating an emergency location identification number (ELIN) with each port equipment number, and [(f)] transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated,” referencing col. 7, lines 56-68, col. 8, lines 1-4 thereof. (See ¶4, pages 3-4 of the Office Action.)(reference letters added.)

The Examiner concludes that it would have been obvious to modify Needham with the teachings of both Tanaka and Hoskinson to provide for “[(c)] storing a port [sic] number for each device/trunk in the PBX/MLTS, and [(e)] determining from which port the emergency call originated and [(d)] associating an emergency location identification number (ELIN) with each port equipment number, and [(f)] transmitting to a public safety answering point the ELIN associated with the port from which [the] emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art.” (see ¶4, page 4 of the Office Action.)(reference letters added.)

Applicants respectfully traverse the stated rejections on several grounds.

First, Applicants submit that because of the deficiencies in the Needham disclosure as discussed above with respect to claims 1 and 8, and because claims 2-3 and 9-10 depend from claims 1 or 8, claims 2, 3, 9 and 10 are believed neither taught nor suggested by the stated combination, and therefore allowable thereover, for at least similar reasons.

Moreover, Applicants submit that claims 2, 3, 9 and 10 are patentably distinct over Needham, Tanaka and Hoskinson in their own right.

With reference to the Office Action dated August 5, 2002, claims 1 and 8 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Tanaka and claims 2-7 and 9-

14 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Hoskinson. A responsive Amendment was filed September 24, 2002 successfully traversing these rejections, in response to which all claims, i.e., 1-14 were allowed in the Office Action dated December 17, 2002. In response to the IDS filed by Applicants on March 17, 2003 citing Needham, in an Office Action dated July 14, 2003, claims 1 and 8 were rejected under 35 U.S.C. §102(a) as being unpatentable over Needham and claims 2-3 and 9-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Needham in view of Tanaka and Hoskinson, which rejections have been maintained in the outstanding Office Action.

With regard to claims 1 and 8, in the August 5, 2002 Office Action, claims 1 and 8 were rejected under 35 U.S.C 102(e) as being anticipated by Tanaka and were successfully distinguished over Tanaka as set forth in the September 24, 2002 response where it was argued, *inter alia*, that Tanaka teaches a system by which one or more trunk lines are reserved for 911 calls, other calls are not permitted to use the reserved trunk line(s) and 911 calls are automatically routed to the reserved trunk line(s) and that Tanaka does not teach or suggest the prioritizing of calls within a private network. In that rejection, it was argued that the Examiner incorrectly interpreted the claimed PBX/MLTS/ private network to read on Tanaka as follows: (See pages 3-4 of the September 24, 2002 response.)

Tanaka discloses a PBX system coupled to the public network (trunk lines). An emergency call in Tanaka is given priority for a trunk line. It is not given priority for traversing a private network. The Examiner reasons that the PBX system in Tanaka is "a private network", but if that interpretation is taken, there is an element in claim 1 unaccounted for, i.e. the claimed PBX/MLTS. If Tanaka's PBX is the claimed private network, there needs to be another PBX coupled to it to read on claim 1. However, Tanaka specifically teaches that his PBX is not coupled to a private network, it is coupled to a public network (trunk lines) when handling an emergency call.

The focus of the invention claimed in claim 1 is to prioritize "an emergency call made from behind a PBX/MLTS coupled to a private network" such that "said call takes priority over other calls in traversing said private network before reaching a public network trunk." The PBX system in Tanaka cannot be BOTH the claimed PBX and the claimed private network. Interestingly, Tanaka DOES disclose a PBX connected to a private network (the leased line 30 in Figure 4). However, as mentioned above, Tanaka specifically teaches that the private network is NOT to be used for emergency calls.

With regard to claims 2, 3, 9 and 10, as pointed out in the September 24, 2002 response to the August 5, 2002 Office Action, the Examiner admitted that Tanaka does not teach or suggest the features of claims 2, 3, 9, and 10 and suggested that these features are taught by Hoskinson and that it would have been obvious to combine the teachings of Hoskinson with those of Tanaka. Applicants successfully argued that such combination was unmotivated and therefore improper. (See page 5, Sept. 24, 2002 Preliminary Amendment.)

In response to Applicants' traversals as set forth *supra*, all claims, including specifically claims 1, 2, 3, 8, 9 and 10, were allowed by the December 17, 2002 Office Action, thus distinguishing these claims over Tanaka and Hoskinson, as well as the other art of record.

With reference to the instant Office Action, the Examiner now re-forms the combination of Tanaka and Hoskinson, this time based upon the primary reference of Needham. As stated above, the Examiner's conclusion is that it would have been obvious to modify Needham to provide for "[ (c) ] storing a port [ sic ] number for each device/trunk in the PBX/MLTS, and [ (e) ] determining from which port the emergency call originated and [ (d) ] associating an emergency location identification number (ELIN) with each port equipment number, and [ (f) ] transmitting to a public safety answering point the ELIN associated with the port from which [ the ] emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art." (See ¶4, page 4 of the Office Action.)

In forming the stated combination, the Examiner dissects the individual teachings of Tanaka and Hoskinson- e.g., taking element (c) of claim 2 and element (e) of claim 3 from Tanaka and elements (d) of claim 2 and (f) of claim 3 from Hoskinson, and combines them with Needham to arrive at the claimed invention as recited in claims 2 and 3. A similar position is expressed with regard to claims 9 and 10.

First, as pointed out in the September 24, 2002 response in traversing a similar rejection of claims 2, 3, 9 and 10 in the August 5, 2002 Office Action, the combination of Tanaka and Hoskinson to form the claimed invention is unmotivated.

Moreover, Needham, which does not teach or suggest the elements of claim 1 or 8 as discussed in detail above, is, by the Examiner's admission, silent as to any of the elements of claims 2, 3, 9 and 10 and the Examiner has not pointed to anything in Needham (or elsewhere for that matter) that would invite such a dissection and recombination of Tanaka or Hoskinson to modify its own teachings.

Thus, as was the case when first proffered, this combination is again not motivated in the prior art. Such unmotivated dissection and combination is formed only with the benefit of the present invention as claimed and is clearly improper. Applicants respectfully submit that a prima facie case of obviousness has not been set forth and these rejections cannot stand.

Claims 2-3 and 9-10 are therefore believed not anticipated by nor rendered obvious in view of Needham, Tanaka and Hoskinson, taken individually or in combination.

Accordingly, claims 1-3 and 8-10 are believed to be allowable for at least the stated reasons.

#### **Allowable Subject Matter**

Claims 4-7 and 11-14 are indicated as allowable if rewritten in independent form. Since the claims upon which these claims depend are believed to be allowable for the reasons set forth *supra*, claims 4-7 and 11-14 have not been amended and are believed to be allowable as pending.

**New Claims 17-20**

New claims 17-20 are presented to alternatively claim the present invention. No new matter is added.

New claims 17-19 depend from claim 1 and are believed allowable for at least similar reasons as set for claim 1 above.

New claim 20 includes the further element of "c) storing a port equipment number for each device/trunk in the PBX/MLTS." Claim 20 is believed allowable for similar reasons as discussed above with regard to claims 1-3.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that claims 1-14 and 17-20 as presented herein are neither anticipated by nor rendered obvious in view of, and thus allowable over, the prior art of record, taken alone or in combination. Applicants respectfully request reconsideration and allowance of this application.

Applicant believes no fees are required for this Amendment. However, should an extension of time be required for the timely submission of this paper, such extension is hereby petitioned and the Commissioner is hereby authorized to charge any additional fees which may be required for this paper, or credit any overpayment, to Deposit Account No. 19-2179.

In the event that a telephone conference would facilitate prosecution, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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